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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.              | CONFIRMATION NO. |
|--|-------------|----------------------|----------------------------------|------------------|
| 10/574,212   | 11/14/2006  | Ping Chen            | 284502000800                     | 7921             |
| 20872  | 7590        | 02/24/2009           |                                  |                  |
| MORRISON & FOERSTER LLP<br>425 MARKET STREET<br>SAN FRANCISCO, CA 94105-2482 |             |                      | EXAMINER<br>LAWRENCE JR, FRANK M |                  |
|  |             |                      | ART UNIT                         | PAPER NUMBER     |
|  |             |                      | 1797                             |                  |
|  |             |                      | MAIL DATE                        | DELIVERY MODE    |
|  |             |                      | 02/24/2009                       | PAPER            |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                   |              |  |
|------------------------------|-------------------|--------------|--|
| <i>Office Action Summary</i> | Application No.   | Applicant(s) |  |
|                              | 10/574,212        | CHEN ET AL.  |  |
|                              | Examiner          | Art Unit     |  |
|                              | Frank M. Lawrence | 1797         |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities: A brief description of Figure 7 (7a and 7b) is required in the specification. A new listing of claims should be provided to clarify that claim 24 has been amended. The current claims contain two each of the end of claim 22, claim 23 and claim 24.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 4, 10, 15 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 4 requires a period "." so that it forms a complete sentence. In line 5 of claims 10, 15 and 17, "or" should be changed to "and" so that they recite a proper Markush group.

### *Double Patenting*

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-7, 10, 12, 21, 22 and 24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 12-15, 17, 26-29, 32, 34-37, 40 and 41 of U.S. Patent No. 6,946,112. Although the conflicting claims are not identical, they are not patentably distinct from each other because all of the limitations of the instant claims are encompassed and envisioned in the patent claims. One skilled in the art would understand that the prior ternary nitrides are inherently capable of desorbing 60% or more of absorbed hydrogen because they are the same compositions recited in the instant claims.

*Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-7, 10, 12, 21, 22 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Chen et al. (2003/0129126 A1).

8. Chen et al. '126 teach ternary nitrides that can be used for reversible hydrogen absorption at -50° C to about 600° C in a reservoir, comprising a mixture of different cations that can include Mg, Li, Mg, Ca or Al (see abstract, paragraphs 62-66, 89-91). The nitrides are inherently

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capable of desorbing 60% or more of absorbed hydrogen because they are the same compositions that are defined in the instant specification.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

9. Claims 1-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Meisner et al. (6,967,012).

10. Meisner et al. '012 teach compositions for hydrogen absorption at room temperature in a reservoir, comprising imides that can include a mixture of metal cations selected from Li, Mg, Al, Ca and Na. The composition can be produced by reacting an amide with a hydride under heat to form the imide product (see col. 2, lines 8-12, col. 3, lines 25-58, col. 4, lines 41-54, col. 5, lines 6-55). The metal cations are disclosed with sufficient specificity such that one skilled in the art would select the combinations recited in the instant claims and understand that atomic balancing must be performed. The prior compositions would inherently be capable of desorbing more than 80% of absorbed hydrogen because they are the same as disclosed in the instant specification.

11. Claims 6, 7, 10, 11, 19 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Pinkerton et al. (2005/0191236 A1).

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12. Pinkerton et al. '236 teach stable intermediate nitrides for hydrogen storage comprising Li or Mg with Al. The specific example  $\text{Li}_3\text{AlN}_2\text{H}_8$  is given (see paragraphs 33-36). The rejected claims do not enjoy the benefit of U.S. Provisional Application 60/507,548 because they recite material not disclosed in the application.

*Conclusion*

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The additional references listed on the attached PTO-892 form disclose hydrogen storage compositions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank M. Lawrence whose telephone number is 571-272-1161. The examiner can normally be reached on Mon-Thurs 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571-272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Frank M. Lawrence/  
Primary Examiner, Art Unit 1797

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